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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,453	01/08/2001	Richard Bolling	ADO 0069 PA	5555

7590

07/02/2003

Killworth, Gottman, Hagan & Schaeff, L.L.P.  
One Dayton Centre, Suite 500  
Dayton, OH 45402-2023

EXAMINER
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RIBAR, TRAVIS B

ART UNIT	PAPER NUMBER
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1711

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DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/756,453

Applicant(s)

BOLLING ET AL.

Examiner

Travis B Ribar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15,17-19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15,17-19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The request filed on May 30, 2003 for Continued Prosecution under 37 CFR 1.114 based on parent Application No. 09/756453 is acceptable and an RCE has been established. An action on the RCE follows.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 15, 17-19, and 21-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the flowing of the sealant during the application of the sealant to a gap or cavity, does not reasonably provide enablement for the flowing of the flow control agent during the application of the sealant to a gap or cavity. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The specification enables the flowing of the sealant during the application of the applicant's multilayer structure to a gap or cavity (page 2, lines 10-13 and page 3, lines 19-24), but nowhere within the specification does it mention that the flow control agent should flow during the application of the multilayer structure to a gap or cavity.

#### ***Claim Rejections - 35 USC § 102***

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 15, 18-19, 21, and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al.

The application of Johnson et al. to the current claims is discussed in paragraph 7 of the office action dated February 14, 2003.

Regarding the applicant's newly added limitation that the flow control agent flow during the application of the multilayer structure, the examiner notes that this limitation is present in Johnson et al. (column 17, lines 51-57), where the flow of one layer is inherently controlled by an adjacent layer having a different flow rate and both of the layers will flow during the application of the sealant to a gap or cavity. In addition, Johnson et al. discloses the use temperature the applicant claims in claim 21, indicating that the sealant flows at that temperature.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. in view of Stokes.

Paragraph 10 of the office action dated February 14, 2003 contains the text of this rejection.

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. in view of Greenwood.

Johnson et al. discloses the invention of claim 15 (see above), but does not include a blowing agent in the sealant composition. Greenwood teaches that a blowing agent in a sealing tape is advantageous because of the improved sealing properties that result (column 1, lines 33-38).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add a blowing agent to the sealant in Johnson et al. The motivation for doing so would be to improve the sealing properties of the resulting multilayer. Therefore it would have been obvious to combine Greenwood with Johnson et al. to obtain the invention as specified in claim 22.

### ***Response to Arguments***

9. Applicant's arguments with respect to claim 22 have been considered but are moot in view of the new ground(s) of rejection.

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10. In response to applicant's argument that there is no suggestion to combine Johnson et al. and Stokes, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in both references.

Johnson et al. teaches that a web or scrim is useful in the tape structure it discloses. The web or scrim improves the strength of the tape (column 15, lines 65-67). Stokes discloses a web that has high strength. The motivation for adding the web from Stokes to the tape structure in Johnson et al. is to utilize the strength of the web in Stokes in the tape in Johnson et al.

11. The applicant's argument that the Johnson et al. does not meet the limitation of claim 25 regarding the width of the gaps that may be sealed is not persuasive. The examiner notes that the limitation in the claim is only a future intended use of the claimed article and does not add any structural limitations to the claimed article. Further, even if the examiner accepted the position that this future intended use did add a structural limitation to the claim, Johnson et al. discloses that there may be webs or scrims present in the tape structure to improve its strength, which would inherently make the tape structure able to seal gaps of the width the applicant claims.

12. The applicant also argues that there is no evidence that the web in Stokes would control the flow of the sealant in Johnson et al. The examiner disagrees and notes that since the web in Stokes would flow at the temperatures listed (see the examples for the bonding temperatures of the web in Stokes, which indicates melting), it will inherently act as a flow control agent of some sort for the layer immediately adjacent to it in the structure shown in Johnson et al., affecting the flow either by slowing it down or increasing its speed.

13. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

George et al. (U.S. Pat. No. 6,287,669) showing a sealant with a flow control agent.

George et al. (U.S. Pat. No. 5,964,979) showing a sealant with a flow control agent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar  
Examiner  
Art Unit 1711

TBR  
June 30, 2003

James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700